REMARKS

Claims 49-53 and 60-62 are pending in this application. As a preliminary matter, Applicants appreciate the Examiner's effort and cooperation to examine the previously presented claims 53-59. However, for purposes of expedition, claims 54-59 have been canceled without prejudice or disclaimer in favor of a divisional application that is filed concurrently herewith. Claims 5-48, which have been previously withdrawn from consideration under 37 C.F.R. §1.142(b) as being drawn to non-elected inventions, are retained at least until the conclusion of claims 49-53 and 60-62 as pending in this application. Separately, claims 49-53 have been amended in several particulars for purposes of clarity and brevity that are unrelated to patentability and prior art rejections, in accordance with current Office policy, to further define Applicants' disclosed invention and to assist the Examiner to expedite compact prosecution of the instant application. Accordingly, entry of the foregoing amendments is proper under 37 C.F.R. §1.116(b) because those amendments simply respond to the issues raised in the final rejection, no new issues are raised, no further search is required, and the foregoing amendments are believed to remove the basis of the outstanding rejections and to place all claims in condition for allowance. The foregoing amendments, or explanations, could not have been made earlier because these issues had not previously been raised.

Claims 49-52 have been newly rejected under 35 U.S.C. §103(a) as being unpatentable over Behr et al., U.S. Patent No. 5,543,789, as modified to incorporate selected features from Sato, U.S. Patent No. 6,009,403. In support of this newly formulated rejection, the Examiner simply refers to paragraph #2 of the Office Action

(Paper No. 29) dated on March 5, 2002. In Paper No. 29, the Examiner asserts that Behr '789, as a primary reference, discloses,

> "a system for transmitting facility data requests from **a vehicle** to a central station, and having such data transmitted back to **a vehicle** for display (col. 3), except for specifically stating that facility icon is displayed on map or that icon shape data is retrieved."

The Examiner then cites Sato '403, as a secondary reference, for teaching "desirability of displaying facility data on a map with respect to current location (Fig. 16) and for retrieving icon data including shape, either circular or triangular (col. 10)" in order to support an assertion that "it would have been obvious to retrieve shape data and display icons on a map in a system as disclosed by Berh, in order to determine more easily what type of facility was close by and its position with respect to a user's location."

However, these assertions are factually incorrect. Applicants respectfully submit that features of Applicants' claims 49-52 are not taught or suggested by Behr '789 and Sato '403, whether taken individually or in combination. Therefore, Applicants respectfully request the Examiner to reconsider and withdraw this rejection for the following reasons.

First of all, Sato '403, as a secondary reference, does **not** qualify as prior art against Applicants' claims 49-52 because Applicants' claim of priority date of September 13, 1996 predates the filing, April 8, 1997 of Sato '403. While Applicants acknowledge that Sato '403 makes reference to an earlier filing date, June 13, 1996 of an application No. PCT/JP96/01598, that earlier filing date cannot be relied upon by the Examiner. This is because the Sato reference is a continuation-in-part (CIP) of

application No. PCT/JP96/01598, and there is **no** evidence that the features allegedly described by Sato '403 and relied by the Examiner is supported by the application No. PCT/JP96/01598.

Secondly, even assuming *arguendo* that Sato '403 does qualify as prior art against Applicants' claims 49-52, which Applicants do not believe, the Examiner's proposed combination of Behr '789 and Sato '403 still does **not** disclose or suggest the several features defined in Applicants' claims 49-52.

For example, Applicants' independent claim 49, as amended, defines a navigation display system for displaying a present position on a map, comprising:

> a map storage device for storing map data;
> a map display for displaying said map by using said map data;
> a retrieval condition setting device for setting up a retrieval condition in order to display a retrieval result as an icon on said map display;
> a communication equipment for transmitting said retrieval condition to an information offering equipment, and for receiving position information of said map and facility information offered by facilities;
> an icon display for displaying said icon based on said facility information at a position on said map corresponding to said position information; and
> a path retrieval device for setting a position as a goal position or a path through position corresponding to said icon selected and retrieving a course so as to display the same, when selecting said icon displayed on said icon display.

Likewise, independent claim 50, as amended, defines a navigation display system for displaying a present position on a map, comprising:

> a map storage device for storing map data;
> a map display for displaying said map by using said map data;
> a retrieval condition setting device for setting up a retrieval condition in order to display a retrieval result as an icon on said map display;

a communication equipment for transmitting said retrieval condition to an information offering equipment, and for receiving information including position information of said icon which is retrieved according to said retrieval condition by said information offering equipment;

an icon retrieving device for retrieving shape information of said icon according to said retrieval condition from said map storage device, and for demanding said communication equipment to provide image data of said icon corresponding to said shape information of said icon, when said icon retrieving device may not retrieve said shape information from said map storage device; and

an icon display for displaying said icon based on at least one of said shape information and said image data at a position on said map corresponding to said position information.

As defined in independent claims 49-50, the characteristic feature of a navigation display system is to retrieve information from an information offering equipment (server) according to a retrieval condition set up on a vehicle terminal (for example), and to display a retrieval result obtained as an icon on a map display on said vehicle terminal. The icon to be displayed is obtained based on facility information offered by facilities at a position on a map corresponding to position information. As a result, the information offering equipment (server) can display its own information, that is, enable to display the icon on the vehicle terminal that is distinguishable from other facilities on the same line.

In contrast to Applicants' claims 49-50, Behr '789, as a primary reference, only discloses a computerized navigation system intended for providing route guidance information from a base unit to a remote mobile unit. As shown in FIG. 1, the computerized navigation system 10 includes a base unit 12, and a remote mobile unit 14 arranged in communication with the base unit 12, via commercial telephone system 25 including a telephone line 24, or a cellular system 38 connected to the telephone line 24. The base unit 12 is fixed, and located at a single central location, such as a central

server used to store a geographical database. The geographical database stores a variety of geographical and position-oriented attributes, such as street addresses, turn restrictions and points of interest, organized according to different parameters, including "restaurant", "museum", and "city" etc.

The remote mobile unit 14 can be a desktop personal computer 16, a laptop personal computer 18, or a pager 20, as shown in FIG. 1, and described on column 6, lines 1-68 of Behr '789. However, each embodiment of the mobile unit 14 is required to be coupled directly to a telephone line 24, regardless of whether the commercial telephone system 25 or the cellular system 38 is utilized, in order to communicate with the base unit 12.

When a request is made from the remote mobile unit 14, such as geographical and position-oriented information, the base unit 12 uses the geographical database to formulate a response for transmission to the remote mobile unit 14 for a visual display to the user. As described on column 4, lines 29-34 of Behr '789, "the display may be a graphical display, showing map portions and providing travel directions along with a display of highway signs and other information. The display may be textual information, providing travel directions."

However, there is **no** disclosure or suggestion from Behr '789 of any display of icon on a map display that is based on facility information offered by facilities received from an information offering equipment (server) at a position on the map corresponding to position information as expressly defined by Applicants' independent claim 49. In addition, there is **no** disclosure or suggestion from Behr '789 that the "position

information of an icon which is retrieved according to said retrieval condition by said information offering equipment" as further defined by Applicants' independent claim 50.

Sato '403, as a secondary reference, does **not** remedy the noted deficiencies of Behr '789. Sato '403 simply discloses a travel plan preparing device 14, as shown in FIG. 1, used for preparing a travel plan, i.e., itinerary, by accessing a database 12 from a terminal and acquiring information about service facilities, such as "restaurant", "amusement park" or "art gallery" (see FIGs. 2A-2B), that exist on the route from a starting location to a destination location, see FIG. 7 and FIG. 11.

Again, there is **no** disclosure or suggestion from Sato '403 of any display of icon on a map display that is based on facility information offered by facilities received from an information offering equipment (server) at a position on the map corresponding to position information as expressly defined by Applicants' independent claim 49, and "position information of an icon which is retrieved according to said retrieval condition by said information offering equipment" as further defined by Applicants' independent claim 50.

The law under 35 U.S.C. §103 is well settled. In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skilled in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior

art, and **not** based on Applicants' disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 2143. In other words, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USQP 494, 496 (CCPA 1970). "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination." ACS Hospital System, Inc v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). The Examiner must point to something in the prior art that suggests in some way a modification of a particular reference or a combination of references in order to arrive at Applicants' claimed invention. Absent such a showing, the Examiner has improperly used Applicants' disclosure as an instruction book on how to reconstruct to the prior art to arrive at Applicants' claimed invention.

In the present invention, the Examiner has ignored to treat the claim invention as a whole, failed to consider all the key limitations of Applicants' claims 49-52, and failed to provide any suggestion or motivation to modify Sato '403 into Behr '789 in order to arrive at Applicants' claims 49-52. For these reasons, Applicants respectfully request that the rejection of claims 49-52 be withdrawn.

Claim 53 has been newly rejected under 35 U.S.C. §103(a) as being unpatentable over Kakihara et al., U.S. Patent No. 5,293,163, as modified to incorporate selected features from Behr, U.S. Patent No. 5,543,789. In support of this rejection, the Examiner asserts that Kakihara '163, as a primary reference, discloses,

"a navigation display 26 comprising setting a retrieval condition SW4C (Fig. 3), displaying a retrieval result (Fig. 10A), wherein icon images in circles changes according to whether or not a parking facility is empty or full, except for specifically stating that a retrieval condition is transmitted and a retrieval result is received."

The Examiner then cites Behr '789, as a secondary reference, for allegedly teaching "desirability to transmit retrieval requests in a vehicle navigation system to a central station, and having such data transmitted back to a vehicle for display (col. 3)" in order to support an assertion that "it would have been obvious to transmit and receive retrieval requests as taught by Berh in a system as disclosed by Kikahara in order to determine more easily maintain data updates by not having outdated data or difficult update techniques (col. 1, line 52-col. 2, line 4)."

However, these assertions are not only incomplete but are also factually incorrect. Applicants respectfully submit that features of Applicants' claim 53 are not taught or suggested by Behr '789 and Kikihara '163, whether taken individually or in combination. Therefore, Applicants respectfully request the Examiner to reconsider and withdraw this rejection for the following reasons.

Applicants' independent claim 53, as amended, defines a navigation display method for displaying a present position on a map, comprising:

setting up a retrieval condition in order to display a retrieval result as an icon on a map display;
transmitting said retrieval condition to an information offering equipment;
receiving a retrieval result transmitted from said information offering equipment corresponding to said retrieval condition transmitted;
displaying said retrieval result as said icon at a corresponding position of said map on said map display according to said position information included in said retrieval result received; and

setting a position as a goal position or a path through position corresponding to said icon selected and retrieving a course so as to display the same, when selecting said icon displayed on said icon display.

Kakihara '163, as a primary reference, discloses another typical navigation system as shown in FIG. 1, having a display unit provided to display road information, including an identification of a road or a building, the location of a road, the connection of roads, the direction of a road (one-way or not) or the location of a parking lot. Again, this type of information is similar to that of Behr '789 and Sato '403.

However, there is **no** disclosure from Kakihara '163, and the Examiner has **not** identified from Kakihara '163, of the display of "an icon (a retrieval result) on a map display," and that "said icon is displayed at a corresponding position of said map on said map display according to said position information included in said retrieval result received" as expressly defined in Applicants' independent claim 53.

Behr '403, as a secondary reference, does **not** remedy the noted deficiencies of Kakihara '163 for reasons discussed against the rejection of Applicants' claims 49-52. Moreover, the Examiner only cites Behr '403 for allegedly disclosing transmission and reception of retrieval requests, which, when incorporated into the system of Kakihara '163, does not arrive at Applicants' claim 53.

In view of the foregoing reasons and the noted deficiencies of the proposed combination, Applicants respectfully request that the rejection of claims 49-52 be withdrawn.

Lastly, claims 54-59 have been newly rejected under 35 U.S.C. §103(a) as being unpatentable over DeLorme et al., U.S. Patent No. 5,802,492, as modified to

incorporate selected features from Behr, U.S. Patent No. 5,543,789. As previously discussed, for purposes of expedition, claims 54-59 have been canceled without prejudice or disclaimer in order to render the rejection moot.

In view of the foregoing amendments, arguments and remarks, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. Should any questions remain unresolved, the Examiner is requested to telephone Applicants' attorney at the Washington DC area office at (703) 312-6600.

To the extent necessary, Applicants petition for an extension of time under 37 CFR §1.136. Please charge any shortage of fees due in connection with the filing of this paper, including extension of time fees, to the Deposit Account of Antonelli, Terry, Stout & Kraus, No. 01-2135 (Application No. 503.35636PX1), and please credit any excess fees to said deposit account.

Respectfully submitted,
ANTONELLI, TERRY, STOUT & KRAUS, LLP

Hung H. Bui (Reg. No. 40,415)
Attorney for Applicant(s)

HHB
(703) 312-6600